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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,515	04/09/2001	Richard L. Schwartz	SMIO.0100001	6719
7590	11/03/2004		EXAMINER	
Thomas R. Felger Baker Botts L.L.P. 98 Jacinto Center Austin, TX 78701			GAUTHIER, GERALD	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,515

Applicant(s)

SCHWARTZ ET AL.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33,38,40,42,43 and 71-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 33,38, 40, and 71-80 is/are allowed.
- 6) ☒ Claim(s) 42,43 and 81-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The indicated allowability of **claims 42-43, 83-84, 86, 90 and 92-95** is withdrawn in view of the newly discovered reference(s) to Wolff et al. (US 5, 327,486) and Vardi et al. (US 6,798,873 B2). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 81, 83, 85-91** are rejected under 35 U.S.C. 102(b) as being anticipated by Wolff et al. (US 5,327,486).

Regarding **claim 81**, Wolff discloses a program product for facilitating mediated virtual communication (column 1, lines 7-10), the program product comprising:

a computer-usable medium (Computer Platform 14 on FIG. 1);

computer instructions encoded in the computer usable medium, wherein the computer instructions, when executed by a processor in a computer system, provide a mediation system that performs operations (FIG. 2) comprising:

receiving, a request for voice-based communication from a communication device of a calling party, wherein the request for voice-based communication requests

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commencement of a telephone call between the communication device of the calling party and a communication device of a called party (column 3, lines 51-60) [The personal telephone manager 12 received the incoming call request from a caller at telephone 22 to establish a call with a called party through use of the palm-top personal computer];

automatically evaluating, contextual information associated with the telephone call, in response to receiving the request for voice-based communication (column 3, lines 51-60) [The personal telephone manager 12 decodes the automatic number identification associated with the calling party and consults the called party profile for handling information];

automatically preparing, a list of follow-through options, based on the contextual information (column 3, lines 61-66) [The personal telephone manager 12 prepares the list of options in FIG. 4 based on the screening of the caller 's information against the called party personal profile maintained in the database];

automatically transmitting a message from the mediation system to the communication device of the called party, wherein the message includes the list of follow-through options to be displayed on the communication device of the called party for selection by the called party (column 4, lines 33-42) [The personal telephone manager 12 delivers the caller' s identification information and also a list of options as stated on FIG. 4 to the called party' s computer to control the incoming call];

receiving a response from the communication device of the called party, wherein the response identifies the selected follow-through option as an option to automatically

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notify the calling party that the called party plans to call the calling party back later (column 5, lines 1-6) [The called party selects to send a reply message to the caller with special instructions such as on FIG. 8]; and

facilitating a mediated follow-through operation based on the selected one of the follow-through options by automatically notifying the calling party that the called party plans to call the calling party back later (column 5, lines 57-65) [The called party chooses among the pre-recorded messages in the personal telephone manager 12 as indicated on FIG. 8, the message is converted to speech and transmitted to the caller by the local exchange network 10].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Bull using the IVR 61 and the queue system as taught by Gisby.

This modification of the invention would offer the capability of automatically notify the caller for a callback later so that the caller would not stand by the phone awaiting for the agent to answer the phone.

Regarding **claim 83**, Wolff discloses after notifying the calling party that the called party plans to call the calling party back later, receiving a communication request from the communication device of the called party (column 6, lines 6-16);

automatically preparing a list of follow-through actions, in response to the communication request (column 6, lines 6-16);

transmitting a text-based message from the mediation system to the communication device of the called party, such that the text-based message causes the communication device of the called party to display the list of follow-through actions for selection by the called party (column 6, lines 17-36);

receiving a response from the communication device of the called party, wherein the response identifies one of the follow-through actions as having been selected by the called party (column 6, lines 17-36); and

automatically facilitating the selected follow-through action, in response to receiving the response from the communication device of the called party (column 6, lines 37-45).

Regarding **claim 85**, Wolff discloses automatically preparing a communication summary in response to receiving the request for voice-based communication from the communication device of the calling party, wherein the communication summary includes identifying information for the calling party (column 4, lines 7-27); and

transmitting the communication summary from the mediation system to the communication device of the called party (column 4, lines 7-27).

Regarding **claim 86**, Wolff discloses the communication summary sent to the communication device of the called party comprises information about previous attempts by the calling party to call the called party (column 3, lines 26-32).

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Regarding **claim 87**, Wolff discloses tracking responses from the called party to multiple communication requests, to identify a recurring response from the called party (column 5, lines 7-23); and

automatically handling a subsequent telephone call to the communication device of the called party on behalf of the called party, in accordance with the recurring response, without receiving input from the called party pertaining to the subsequent call (column 5, lines 7-23).

Regarding **claim 88**, Wolff discloses receiving input from the called party specifying a default option for mediating incoming calls for the called party (column 4, lines 43-53); and

automatically mediating an incoming call to the communication device of the called party on behalf of the called party, in accordance with the default option, without receiving input from the called party pertaining specifically to that incoming call (column 5, lines 1-6).

Regarding **claim 89**, Wolff discloses automatically providing instructions to a person that originated the incoming call, wherein the instructions pertain to leaving voice mail for the called party (column 4, lines 63-64).

Regarding **claim 90**, Wolff discloses automatically mediating the incoming call in accordance with a behavior-specific follow-through action (column 3, lines 61-66).

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Regarding **claim 91**, Wolff discloses automatically interacting with a person that originated the incoming call, on behalf of the called party, to schedule a follow-up call (FIG. 8).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. **Claims 42-43, 84 and 92-95** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff in view of Vardi et al. (US 6,798,873).

Regarding **claims 92 and 94**, Wolff discloses all the limitation of **claims 92 and 94** as stated in the rejection of **claim 81** above but fails to disclose automatically calling a communication device of a second person on behalf of the user, automatically determining a present availability status of the second person and automatically connecting the communication device of the user and the communication device of the second person.

However, Vardi automatically calling a communication device of a second person on behalf of the user, in response to receiving the response from the communication device of the user (column 8, lines 1-6) [The user 10 indicates that a call back is to be tried to the caller by providing a the telephone number to be called];

automatically determining a present availability status of the second person by interacting with the second person on behalf of the user (column 8, lines 1-6) [The user 10 indicates that a call back is to be tried to the caller when the telephone number provided is available]; and

in response to determining that the second person is available, automatically connecting the communication device of the user and the communication device of the second person, to facilitate communication between the user and the second person, wherein the mediation system connects the communication device of the user and the communication device of the second person only after the mediation system interacts

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with the second person and determines that the second person is available (column 7, line 50 to column 8, line 6) [The user 10 indicates that a call back is to be tried to the caller by providing a the telephone number to be called and upon availability an automatic switch dialed the number to be communicated with the caller and connected to the called party via the communications network].

Regarding **claim 42**, Wolff discloses automatically analyzing a profile for the user, in response to receiving the communication request (column 3, lines 61-66); and preparing the list of follow-through actions, based on the profile for the user (column 3, lines 61-66).

Regarding **claim 43**, Vardi discloses automatically determining a present availability status for the user, in response to receiving the communication request from the communication device of the user (column 8, lines 1-6).

Regarding **claim 84**, Vardi discloses the selected follow-through action comprises an option to return a call (column 6, lines 36-49); and the operation of automatically facilitating the selected follow-through action comprises:

automatically calling the communication device of a the calling party on behalf of the called party, in response to receiving the response from the communication device of the called party (column 8, lines 1-6);

automatically determining a present availability status of the calling party, based on interactions between the calling party and the mediation system (column 8, lines 1-6); and

automatically connecting the communication device of the called party and the communication device of the calling party, to facilitate communication between the called party and the calling party, wherein the mediation system connects the communication device of the called party and the communication device of the calling party only after the mediation system interacts with the calling party and determines that the calling party is available (column 7, line 50 to column 8, line 6).

Regarding **claims 93 and 95**, Wolff discloses receiving a text-based response from the communication device of the user, wherein the text-based response identifies the selected follow-through action (column 4, lines 7-27).

Allowable Subject Matter

7. **Claims 33,38, 40, 71-80** are allowed.
8. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claim 33**, the prior art at this time fails to suggest automatically updating the subscriber profile by archiving at least one of identifying information of the calling party' an availability status of the called party during a mediation process for the request for voice-based communication and information about the follow-through option selected by the called party during the mediation.

Response to Arguments

9. Applicant's arguments with respect to **claims 42-43, 81 and 83-95** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

g.g.

November 1, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', written over the printed name and title.